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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,857	02/09/2001	Annie Audibert	612.39487X00	8221

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EXAMINER

SZEKELY, PETER A

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/779,857

Applicant(s)

AUDIBERT ET AL.

Examiner

Peter Szekely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: The specification, on page 3, line 20, still shows S1 and S2 as hydrophilic/hydrophobic copolymers. On page 3, lines 22-23, the particle size ranges of silica and microsilica overlap. Is silica having a particle size of 5-20 microns silica or microsilica? Appropriate correction is required.

### *Election/Restriction*

2. Newly submitted claims 11-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claimed composition can be used for controlling the solids distributions in drilling operations, classified in class 523, subclass 130, while the claimed method belongs to class 524, subclass 5.

ps.  
4/2/03

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Claim Rejections - 35 USC § 112*

- 3 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4 Claims 1-3, 5 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Mr. Muller's Declaration has been considered, but the Declaration in itself is insufficient to obviate the rejection. The weight average molecular weights of the polymers have to be inserted into the claims and into the specification replacing the claimed molecular masses.

5 Claims 1-3, 5 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no hydrophilic/hydrophobic copolymer shown in the specification, which has a weight average molecular weight of 500,000. That molecular weight belongs to a completely hydrophilic copolymer.

6. Claims 1-3, 5 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no hydrophilic/hydrophobic copolymer having a weight average molecular weight of 500,000 mentioned in the specification. This is new matter.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-3, 5 and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. In claims 8-10 the particle sizes of the silica and the microsilica overlap. Where does silica having a particle size of 5-20 microns belong? "Molecular mass" without specifying the proper average molecular weight is indefinite.

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-3, 5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynn 4,525,500 or Yamato et al. 5,707,445, in view of Koga et al. 4,662,942 or Yamaguchi et al. 4,888,059, further in view of Argillier et al. 5,637,556 or Audibert et al. 5,597,783.

12. All of the references have been discussed already. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to add the polymer of Koga et al. to the compositions of the primary references, since it is of a similar composition and used in the same field, and to use molecular weights in the same range as the terpolymer of Yamaguchi et al., who show the customary molecular weight range.

***Response to Arguments***

13. Applicants' arguments filed 3/10/03 have been fully considered but they are not persuasive. In spite of the Declaration of Mr. Muller, unless the weight average

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molecular weight is inserted into both the specification and the claims, at every place where molecular mass is mentioned, the 112 rejections will be maintained, since the Declaration will not be a part of a published patent. The rejection for indefiniteness is maintained because it is not likely that one of ordinary skill in the art would start drawing bell curves prior to using a particular grade of sand, in order to establish the Gaussian distribution of particle sizes. Applicants' specification does not specify any particle size distribution; it talks only about particle sizes. The 500,000 lower limit of the claimed molecular weight range belongs to the polymers S1 and S2, which are not in claims 1-3, 5 and 8-10 as hydrophobic/hydrophilic copolymers anymore. Because of the indefiniteness of the particle sizes of the sand claimed, the examiner includes the entire 0.1-200 micron range as meeting applicants' requirements and said range is so broad as to include all of the known silicon dioxides available. Lynn discloses several commercially available copolymers, which have molecular weights within applicants' claimed range. The burden is shifted to applicants to prove otherwise. The sieved pit sand of Examples 1-8, (0-2.36 mm), encompasses applicants' claimed particle size range. When X is an alkyl group having 1-3 carbon atoms, the copolymer of Yamato et al. is hydrophilic/hydrophobic. The molecular weight is 300-1,000,000 (claim 4). The pyrogenic silica, (column 6, line 60), has particle sizes within applicants' claimed range. Applicants' claims are directed to a composition. A composition, is a composition, is a composition. The intended use has no patentable significance. Furthermore, if a copolymer were useful for filtrate reduction in well fluids, it would have been obvious to

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use it for filtrate reduction in well bores. The role of the copolymers is identical. The rejections are maintained.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Peter Szekely  
Primary Examiner  
Art Unit 1714

P.S.  
April 21, 2003